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09/826,898	04/06/2001	Maroka Ueda	205727US-2	6383

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EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,898

Applicant(s)

UEDA ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/6/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/30/02; 7/30/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: “a controller for sending second image information which represents the at least one element to the information processing apparatus” is unclear whether the “second image information” is sent from the controller to the “information processing apparatus” or to the “image processing apparatus”. Appropriate correction is required.

### **Claim Rejections - 35 USC § 101**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17 & 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuka (U.S. 6327049), and in view of Ueda et al (U.S. 6525770).

Regarding claim 1, an image processing apparatus (laboratory print server apparatus, fig. 2) comprising:

- a communication unit (network 10, fig. 1) for communicating with an information processing apparatus (client computer 5, figs. 1-2) having a function of operating image information;
- a storage (template server for storing plurality of high resolution templates 4, fig. 2) for storing first image information which represents at least one element in a compressed format therein; and
- a controller (user terminal 5, figs. 2-3) for sending second image information (order file 6 with low resolution templates downloaded from the server, fig. 2, col. 7, lines 38-42) which represents the at least one element to the information processing apparatus, the amount of the second image information being smaller than that of the first image information (inherently, high resolution image from the template server is higher/larger than the low resolution template sent from the client apparatus, figs. 2-4, col. 6, lines 60-67 to col. 7, lines 1-50), acquiring result information (print order information as shown in tables 1-8 includes finishing options, cols. 10-13) representing an operation which is executed for the sent second image information on the information processing apparatus, editing (laboratory server apparatus for editing high resolution templates with respect to print order file along with finishing options sent from the client apparatus, fig. 2-4, cols. 7-8) the first image information according to the acquired result information in an intermediate process where the first image information stored in the storage is expanded (expands the high resolution templates via image server, fig. 3, cols. 7-8).

Ohtsuka also discloses a communication network (network 10, fig. 1) for communicating between client and laboratory print apparatus, but does not expressly disclose sending image information in the "compressed format" to the information processing apparatus.

Ueda, in the same field of communication, teaches a communication apparatus/method for sending the image information in "compressed format" to the information processing apparatus (transmitting the compressed image data from the server to the client, col. 19, lines 50-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ohtsuka as per teachings of Ueda because of a following reason: (1) to allow the laboratory print server to transmit the edited image (fig. 6, Ohtsuka) back to the client in the compressed format; and therefore to enable the client to print the edited image by his/her own terms.

Therefore, it would have been obvious to combine Ohtsuka with Ueda to obtain the invention as specified in claim 1.

Regarding claim 2, Ohtsuka further discloses the image processing apparatus according to claim 1, wherein the controller executes at least one of a moving process, an enlargement process, a reduction process and a deletion process (i.e. image processing specification, tables 3-8, cols. 11-13) on the at least one elements to edit the first image information in the intermediate process.

Regarding claim 3, Ohtsuka further discloses the image processing apparatus according to claim 1, wherein the controller edits the first image information in the intermediate process according to the acquired result information such that one of the at least one element is superimposed (fig. 6) on another of that when the first image information represents a plurality of elements.

Regarding claim 4, Ohtsuka further discloses the image processing apparatus according to claim 1, wherein a network is provided to connect among the image processing apparatus, the information processing apparatus and other information processing apparatuses (network 10, fig.

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1), and the controller broadcasts the first image information which is edited and composed to a plurality of desired information processing apparatuses of the information processing apparatus and the other information processing apparatuses.

Regarding claim 6, Ohtsuka further discloses an image processing apparatus (laboratory print server apparatus, fig. 2) comprising: a communication unit (network 10, fig. 1) for communicating with an information processing apparatus which processes first image information and second image information in association with each other, both of the first image information and the second image information representing at least one element and the amount of the second image information being smaller than that of the first image information (inherently, high resolution image from the template server is higher/larger than the low resolution template sent from the client apparatus, figs. 2-4, col. 6, lines 60-67 to col. 7, lines 1-50); an image processor (ref. 2, fig. 2) for receiving the second image information from the information processing apparatus (client apparatus, fig. 1) via the communication unit, displaying the received second image information on a given display device (display device, 2a-2c, fig. 1), receiving an operation instruction (print order information as shown in tables 1-8, cols. 10-13) for the displayed second image information, processing the displayed second image information according to the operation instruction and sending result information representing the processed and displayed second image information to the information processing apparatus; and an output controller (laboratory print server, fig. 2) for receiving the first image information (high resolution template, fig. 2) via the communication unit, which is edited according to the result information on the information processing apparatus, and causing a given printing device (print, fig. 2) to print the received first image information.

Regarding claim 7, Ohtsuka further disclose the image processing apparatus according to claim 6, wherein when the operation instruction includes adding process for adding additional information (i.e. text, fig. 6) to the displayed second image information, the image processor saves the additional information, and the output controller executes a superimpose process (fig. 6) for the received first image information and the saved additional information and causes the given printing device (print, fig. 2) to print a result of the superimpose process.

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Regarding claims 8-12: Claims 8-12 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-3 and 6-7; therefore, claims 8-12 are rejected for the same rejection rationale/basis as described in claims 1-3, and 6-7 above.

Regarding claims 13-14: Claims 13-14 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-4 and 6-7 and/or combination thereof; therefore, claims 13-14 are rejected for the same rejection rationale/basis as described in claims 1-3, and 6-7 above.

Regarding claims 15-20: Claims 15-20 corresponds to claims 1-3, 6-7 and/or combinations thereof except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have some type of computer readable memory medium for storing computer programs, hence claims 15-20 would be rejected using the same rationale as in claims 1-3, 6-7.

Regarding claims 21-22 recite limitations that are similar and in the same scope of invention as to those in claims 1-3 above; therefore, claims 21-22 are rejected for the same rejection rationale/basis as described in claims 1-3.

Regarding claims 23-25: Claims 23-25 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-4 and 6-7 and/or combination thereof; therefore, claims 23-25 are rejected for the same rejection rationale/basis as described in claims 1-3, and 6-7 above.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuka and Ueda as applied to claim 1 above, and further in view of McCain et al (U.S. 5309351).

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Regarding claim 5, the combinations of Ohtsuka and Ueda do not expressly teach a system includes a satellite communication network.

McCain, in the same field of endeavor for network communication, teaches a satellite communication network (fig. 1-3).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ohtsuka and Ueda as per teachings of McCain because of a following reason: (1) to implement the system as disclosed by Ohtsuka (fig. 1) via using a satellite communication (wireless) system; therefore, allowing the operators to operate his/her computer virtual anywhere due to its wireless capabilities.

Therefore, it would have been obvious to combine Ohtsuka with Ueda to obtain the invention as specified in claim 5.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents/publications are relevant to applicant's disclosure invention.

- U.S. 5436734 to Yamauchi et al, teaches an image-edit processing apparatus/system.
- U.S. 5687332 to Kurahashi et al, teaches an image-edit processing system that allows multiple/plurality of images to be superimposed/combined.
- U.S. 6124841 to Aoyama, teaches an image-edit processing system that allows multiple/plurality of images to be superimposed/combined and a system for enlarging/reducing the resulted and/or pre-processed images.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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